

REMARKS/ARGUMENTS

The Applicants originally submitted Claims 1-9 in the application. In the present preliminary amendment, the Applicants have amended Claims 1-4 and 6-9. Additionally, the Applicants have added Claim 10. No other claims have been amended, added or canceled. Accordingly, Claims 1-10 are currently pending in the application.

I. Rejection of Claims 1-9 under 35 U.S.C. §103

Previously, the Examiner rejected Claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,289,151 to Kazarinov, *et al.* in view of U.S. Patent No. 6,385,353 to Boyne, *et al.* The Applicants respectfully disagree.

For a determination of obviousness, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention. A reference that teaches away from a claimed invention strongly indicates nonobviousness. Additionally, determination of obviousness requires consideration of the invention considered as a whole. In other words, the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

The Examiner recognizes Kazarinov does not teach or suggest an incrementally variable optical delay line but cites Kazarinov to teach a continuously variable optical delay line. (See point 3 on page 2 of the Office Action mailed May 26, 2005.) Kazarinov discloses an all-pass optical filter that reduces dispersion of optical pulses passing therethrough by applying a desired phase response to the optical pulses. (See column 5, lines 38-42.) Kazarinov, however, does not teach or suggest a continuously variable optical delay line configured to delay a received optical signal by a continuous delay length selected from a continuum of delay lengths having a range substantially encompassing a delay increment of an incrementally variable optical delay line that is optically and serially coupled thereto as recited in amended independent Claim 1. Instead, as mentioned above, Kazarinov is concerned with an all-pass optical filter that reduces the dispersion of optical pulses. (See column 3, lines 8-13.) Nevertheless, the Applicants do not find where Kazarinov teaches or suggests a continuum of delay lengths having a range substantially encompassing a delay increment of an incrementally variable optical delay line coupled thereto. Thus, while Kazarinov may teach a continuous variable delay, Kazarinov does not teach or suggest a continuously variable optical delay line as claimed in amended independent Claim 1.

Boyne has not been cited to cure the above deficiency of Kazarinov but has been cited to teach optical delay lines having different path regions of parallel paths and curve paths. (See point 3 on page 3 of the Office Action.) Additionally, the Applicants do not find where Boyne cures the above deficiency of Kazarinov since Boyne also does not teach or suggest a continuously variable

optical delay line as recited in amended independent Claim 1. Instead, Boyne is directed to an electrically tuneable optical filter. (See column 1, lines 4-7.)

Thus, the cited combination of Kazarinov and Boyne, individually or in combination, fails to teach or suggest a continuously variable optical delay line configured to delay a received optical signal by a continuous delay length selected from a continuum of delay lengths having a range substantially encompassing a delay increment of an incrementally variable optical delay line that is optically and serially coupled thereto as recited in amended independent Claim 1. The cited combination of Kazarinov and Boyne, therefore, fails to provide the required third criteria to establish a *prima facie* case of obviousness of Claim 1 and Claims dependent thereon. Accordingly, the Applicants respectfully request the Examiner withdraw the §103(a) rejection of Claims 1-9 and allow issuance thereof.

Furthermore, the Examiner has argued one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In addressing the Appellants' previous arguments regarding independent Claim 1, the Examiner cites *In re Keller* to assert that the Appellants cannot show non-obviousness by attacking the references individually where the rejections are based on a combination of references. (See page 3, Examiner's Action.) The Appellants respectfully disagree with the Examiner's application of *In re Keller* to the previous arguments.

In *In re Keller*, the appellant offered an affidavit as objective evidence of non-obviousness. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA) 1981. The court, however, noted that the affidavit concerned itself mainly with the question of whether only one of the cited references (Walsh) suggested the elements of the claimed invention. *In re Keller*, 642 F.2d 413.

In the previous arguments and the above arguments, the Applicants did not argue that only one of the references did not teach or suggest each of the elements of independent Claim 1. Instead, the Applicants argued that neither reference, Kazarinov nor Boyne, taught or suggested each element of Claim 1. Thus, the cited combination did not teach or suggest each element of independent Claim 1. Accordingly, the Applicants disagree with the application of *In re Keller* and request the allowance of pending Claims 1-10.


II. Conclusion

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-10.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

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